

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

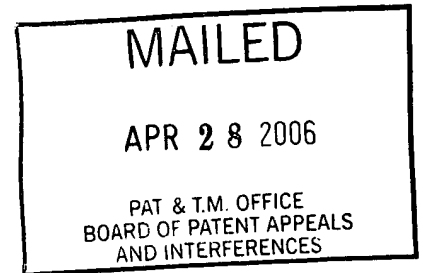
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ERIC COLIN

Appeal No. 2005-2714
Application No. 09/830,096

ON BRIEF



Before FRANKFORT, CRAWFORD, and BAHR, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 4 and 7 through 18. Claim 20 stands allowed. Claims 5 and 6, the only other claims remaining in the application, have been objected to as being dependent upon a rejected base claim, but also have been indicated to be

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allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims. Claim 19 has been canceled.

Appellant's invention relates to an assembly used to actuate components, for example, door locks, door latches, or door deadbolts in vehicles. Claims 1, 9 through 15 and 20 are representative of the subject matter on appeal and a copy of those claims can be found in the Appendix attached to appellant's brief.

The only prior art reference relied upon by the examiner in rejecting the appealed claims is:

Ohkawa et al. (Ohkawa) 5,009,296 Apr. 23, 1991

Claims 9 through 15 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. In the examiner's view, the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

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Claims 1 through 4, 7, 8 and 16 through 18 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Ohkawa.

Rather than reiterate the examiner's full statement of the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellant regarding those rejections, we make reference to the final rejection (mailed December 12, 2003) and answer (mailed September 8, 2004) for the examiner's reasoning in support of the rejections, and to appellant's brief (filed May 17, 2004) and reply brief (filed November 12, 2004) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art reference, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determinations which follow.

We turn first to the examiner's rejection of claims 9 through 15 under 35 U.S.C. § 112, first paragraph, as being based

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on a non-enabling disclosure. It is by now well-established law that the test for compliance with the enablement requirement in the first paragraph of 35 U.S.C. § 112 is whether the disclosure, as filed, is sufficiently complete to enable one of ordinary skill in the art to make and use the claimed invention without undue experimentation. Note, In re Moore, 439 F.2d 1232, 1236 169 USPQ 236, 239 (CCPA 1971). See also In re Scarborough, 500 F.2d 560, 566, 182 USPQ 298, 302-03 (CCPA 1974) and In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). Moreover, in rejecting a claim for lack of enablement, it is also well settled that the examiner has the initial burden of advancing acceptable reasoning inconsistent with enablement in order to substantiate the rejection. See In re Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563 (CCPA 1982); In re Marzocchi, 439 F.2d 220, 223-24, 169 USPQ 367, 369-70 (CCPA 1971). Once this is done, the burden shifts to appellant to rebut this conclusion by presenting evidence to prove that the disclosure in the specification is enabling. See In re Doyle, 482 F.2d 1385, 1392, 179 USPQ 227, 232 (CCPA 1973); In re Eynde, 480 F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973).

In the case before us, after reviewing the disclosure as set forth in the specification and appellant's claims 9 through 15, we are of the opinion that the examiner has not met his burden of advancing acceptable reasoning inconsistent with enablement. The examiner's position as set forth in the final rejection (page 2) is merely that "[t]he structure of the housing is unclear." The examiner makes no attempt to explain why the disclosure in the application concerning the housing to be associated with the actuator assembly seen in Figures 1-3 would be inadequate to enable one skilled in the art to make and use the claimed invention without undue experimentation. In the answer (page 3), the examiner makes note of the fact that appellant did not illustrate the housing and urges that notwithstanding the description in the specification one skilled in the art "could not make use of the invention because the shape of the housing is not described."

Although it is true that appellant has not complied with 37 CFR § 1.83(a) by showing the features of the housing set forth in claims 9 through 15 in the drawings of the application, this oversight alone does not justify the examiner's rejection under 35 U.S.C. § 112, first paragraph, based on non-enablement. Like

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appellant, we are of the view that housings of the type disclosed in the present application for enclosing and sealing a door lock actuator assembly within a door of a motor vehicle are common in the art and would have been well known to one of ordinary skill in the art. Moreover, given the simplistic nature of the claimed subject matter of the housing, we find no reason why a skilled artisan would have been unable to make and use the claimed invention. The examiner has provided no explanation as to why making and using a housing like that set forth in claims 9 through 15 on appeal would have required undue experimentation. As for the examiner's concern that the exact shape of the housing is not known, we agree with appellant that the overall shape of the housing is irrelevant to providing proper support for the specific features of the housing as set forth in claims 9 through 15.¹

For the above reasons, we will not sustain the examiner's rejection of claims 9 through 15 under 35 U.S.C. 112, first paragraph, as being based on a non-enabling disclosure.

¹ We note that it is clear from page 2 of the final rejection mailed December 12, 2003 that the examiner has refused entry of the proposed drawing corrections filed September 22, 2003.

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We next consider the examiner's rejection of claims 1 through 4, 7, 8 and 16 through 18 under 35 U.S.C. § 102(b) as being anticipated by Ohkawa. In maintaining this rejection, the examiner relies on the embodiment of the power transmission apparatus seen in Figures 1 and 2 of Ohkawa. According to the examiner, that apparatus constitutes an actuator assembly including a motor (140) having a body portion (120) and a drive shaft (141), and a pinion (151) directly fixed to the drive shaft to always rotate in unison with the drive shaft, the pinion drivingly engaging an array of gear teeth of a gear rack (115), wherein the gear rack is pivotally mounted via a pivot (114) about a pivot axis located on a motor side of the array of gear teeth.

For the reasons adequately set forth on pages 6-9 of the brief and in the reply brief (pages 2-4), we find that Ohkawa (Figs. 1-2) does not anticipate the actuator apparatus defined in claims 1 through 4, 7, 8 and 16 through 18 on appeal. Appellant's independent claims 1 and 17 each set forth the requirement for a pinion "directly fixed to the drive shaft [of the motor] to always rotate in unison with the drive shaft." Contrary to the examiner's position on page 4 of the answer, that

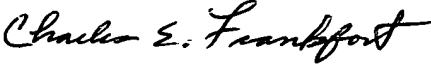

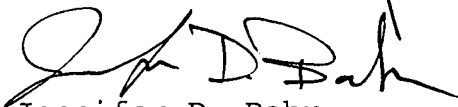
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limitation is not merely a functional limitation, but is instead a structural limitation that unequivocally requires the pinion to be fixedly attached directly to the drive shaft and to always rotate in unison with the drive shaft. No such structural arrangement is found in Ohkawa, wherein the pinion (151) is engaged with the drive shaft (141) of motor (140) via a traveling electromagnetic clutch (150) only when it is necessary to move the motor's drive shaft into alignment with one of the various operating shafts (130) using pinion gear (151) and rack gear (115). The pinion gear (151) is disconnected from the drive shaft of the motor when power-transmitting clutch (160) is utilized to connect the drive shaft to a selected one of the operating shafts (130). See column 3, line 42 through column 5, line 35 of Ohkawa. Moreover, we note that in the embodiment seen in Figures 1 and 2 of Ohkawa, it is the rotary body (120) and motor (140) which move or rotate, not the gear rack as required in appellant's claims on appeal. For those reasons, we will not sustain the examiner's rejection of claims 1 through 4, 7, 8 and 16 through 18 under 35 U.S.C. § 102(b) as being anticipated by Ohkawa.

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Since neither of the rejections before us on appeal has been sustained, it follows that the decision of the examiner is reversed.

REVERSED

	
Charles E. Frankfort)
Administrative Patent Judge)
)
)
Murriel E. Crawford)
Administrative Patent Judge)
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)
Jennifer D. Bahr)
Administrative Patent Judge)

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